

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ROY MCGEE  
and FRANCINA MCGEE

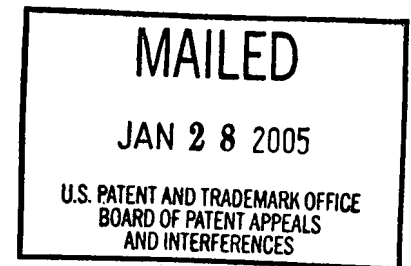
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Appeal No. 2005-0308  
Application 09/934,349

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ON BRIEF

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Before WARREN, WALTZ and TIMM, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

*Decision on Appeal*

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 1 through 6, all of the claims in the application.

Claim 1, as it stands on appeal,<sup>1</sup> illustrates appellants' invention of a heated coffee mug, and is representative of the claims on appeal:

1. A heated coffee mug comprising:

a cup with a handle extending laterally outward from a perimeter sidewall and forming an upper opening orifice;

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<sup>1</sup> We observe that appealed claim 1 as it stands of record in the amendment of August 18, 2003 (Paper No. 13, page 2) has a period, ".", before the semicolon following the word "handle" in the third clause of the claim

a lid for affixing to said cup to enclose said upper opening orifice;

a base for receiving said cup and provide stability on a horizontal surface, said base circumscribing a bottom of said cup by a perimeter wall extending upward from said base of a sufficient distance to prevent sliding of said cup from said base, said perimeter wall being of limited height such as not to interfere with said handle; and

a heating element retained within said base, said heating element powered by 12 volts DC as provided by a motor vehicle to maintain the hot temperature of the contents of said cup.

The references relied on by the examiner are:

|          |           |               |
|----------|-----------|---------------|
| Gordon   | 5,023,433 | Jun. 11, 1991 |
| Stein    | 6,072,161 | Jun. 6, 2000  |
| Vanselow | 6,075,229 | Jun. 13, 2000 |
| Dam      | 6,121,585 | Sep. 19, 2000 |

The examiner has advanced the following grounds of rejection on appeal:

claim 1 stands rejected under 35 U.S.C. § 102(b) as anticipated by Vanselow (answer, page 4);

claims 2, 3 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Vanselow in view of Stein (answer, pages 4-5);

claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Vanselow in view of Stein as applied to claims 2, 3 and 6, and further in view of Dam (answer, page 6); and

claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Vanselow in view of Stein as applied to claims 2, 3 and 6, and further in view of Gordon (answer, pages 6-7)

Appellants group the appealed claims based on the grounds of rejection (brief, page 4; see also answer, page 3). Thus, we decide this appeal based on appealed claim 1, 2, 4 and 5.

37 CFR § 1.192(c)(7) (2003); *see also* 37 CFR § 41.37(c)(1)(vii) (effective September 13, 2004; 69 Fed. Reg. 49960 (August 12, 2004); 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)).

We affirm.

Rather than reiterate the respective positions advanced by the examiner and appellants, we refer to the answer and to the brief for a complete exposition thereof.

### *Opinion*

We have carefully reviewed the record on this appeal and based thereon find ourselves in agreement with the supported findings advanced by the examiner that as a matter of fact, *prima facie*, Vanselow discloses embodiments that include each and every element of the claimed invention encompassed by appealed claim 1, arranged as required by that claim, either expressly or under the principles of inherency. *See generally, In re Schreiber*, 128 F.3d 1473, 1477,

44 USPQ2d 1429, 1431 (Fed. Cir. 1997); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677-78, 7 USPQ 1315, 1317 (Fed. Cir. 1988); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). Thus, we again consider the record as a whole with respect to this ground of rejection in light of appellants' rebuttal arguments in the brief. *See generally, In re Spada*, 911 F.2d 705, 707 n.3, 15 USPQ2d 1655, 1657 n.3. (Fed. Cir. 1990).

Appellants submit that "[t]he present invention includes a number of features that are unanticipated in [Vanselow]," listing five features that are allegedly not found in the reference (brief, page 5).

We interpret appealed claim 1 by giving the terms thereof their broadest reasonable interpretation in light of the written description in appellants' specification, including the drawings, as it would be interpreted by one of ordinary skill in this art, without reading into the claims any limitation or particular embodiment disclosed in the specification. *See In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *In re Priest*, 582 F.2d 33, 37, 199 USPQ 11, 15 (CCPA 1978). It is well settled that applicants' mere intent as to the scope of the claimed invention does not so limit the scope of a claim which is otherwise definite when construed in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Cormany*, 476 F.2d 998, 1000-02, 177 USPQ 450, 451-53 (CCPA 1973).

It is apparent from the plain language of appealed claim 1 that the third and fifth argued features, that is, "[t]he ability to use the base with a standard drinking mug" and "a flexible resistive type heater . . ." (brief, page 5), are not stated limitations in this claim as it stands on appeal. Accordingly, while such features can be present in a heated coffee mug which otherwise contains all of the required limitations of the claim in view of the transitional term "comprising," *see generally, Vehicular Technologies Corp. v. Titan Wheel Int'l Inc.*, 212 F.3d 1377, 1383, 54 USPQ2d 1841, 1845 (Fed. Cir. 2000); *Genentech Inc. v. Chiron Corp.*, 112 F.3d 4954, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997); *In re Baxter*, 656 F.2d 679, 686 210 USPQ 795, 802 (CCPA 1981), there is no requirement that a heated coffee mug meeting the stated limitations of the claim must also have the third and fifth argued features.

We agree with the examiner's findings (answer, pages 7-10) that as a matter of fact, the first, second and fourth features argued by appellants are limitations of appealed claim 1 that are found in a heated coffee mug taught by Vanselow.

Accordingly, we have again considered the totality of the record before us, weighing all of the evidence of anticipation found in Vanselow with appellants' countervailing arguments for non-anticipation in the brief, and based thereon, conclude that the claimed invention encompassed by appealed claim 1 would have been anticipated as a matter of fact under § 102(b).

Based on our review of the record, we further are in agreement with the supported conclusion advanced by the examiner that as a matter of law, *prima facie*, the claimed heated coffee mug apparatus encompassed by appealed claims 2, 4 and 5 would have been obvious over the combined teachings of Vanselow and Stein, the combined teachings of Vanselow, Stein and Dam and the combined teachings of Vanselow, Stein and Gordon, respectively, to one of ordinary skill in this art at the time the claimed invention was made. (answer, pages 4-7). Thus, we again consider the record as a whole with respect to these ground of rejection in light of appellants' rebuttal arguments in the brief. *See generally, In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

While we generally agree with appellants' statements of the holdings of decisions by our reviewing court and its predecessor court (brief, pages 5-9), we find little argument that correlates such legal tenets to the facts in the record before us. Indeed, the sole factual allegations set forth by appellants involve the alleged "making [*sic*, a] heating element powered by a vehicle's electrical system for heating a conventional drinking mug in a manner that flexibly retains the mug in firm mechanical contact" (brief, page 7, lines 8-10). However, as the examiner points out (answer, page 7), the feature alleged by appellants is neither disclosed nor claimed.

Accordingly, based on our consideration of the totality of the record before us, we have weighed the evidence of obviousness found in the combined teachings of Vanselow and Stein, the combined teachings of Vanselow, Stein and Dam and the combined teachings of Vanselow,

Stein and Gordon, with appellants' countervailing evidence of and argument for nonobviousness and conclude that the claimed invention encompassed by appealed claims 2 through 6 would have been obvious as a matter of law under 35 U.S.C. § 103(a).

The examiner's decision is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (effective September 13, 2004; 69 Fed. Reg. 49960 (August 12, 2004); 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)).

*AFFIRMED*

*Paul F. Herman*

CHARLES F. WARREN  
Administrative Patent Judge

THOMAS A. WALTZ

THOMAS A. WALTZ  
Administrative Patent Judge

Catherine Turner

CATHERINE TIMM  
Administrative Patent Judge

# BOARD OF PATENT APPEALS AND INTERFERENCES

Appeal No. 2005-0308  
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